

REMARKS

I. Status of the Claims

With entry of this amendment, claim 25 is pending. Applicant has cancelled claims 1-24 and 26-30 without surrender or disclaimer of the subject matter recited therein. Applicant has amended claim 25 by deleting the phrase “derived from,” and has further amended the claim to simplify the claim language and to fully recite “Collection Nationale de Cultures de Microorganismes.” Applicant also presents new claim 31. Support for this claim can be found in Example 2 of the specification. No new matter is presented.

II. Claim Objections

The Office objects to claims 4-24 and 26-30 under 37 C.F.R. § 175(c) because those claims are multiple dependent claims and cannot depend from multiple dependent claims. Office Action, p. 2.

Applicant has cancelled claims 4-24 and 26-30, which obviates the objection, and respectfully requests that it be withdrawn.

III. Claim 25 Satisfies 35 U.S.C. § 112, first paragraph

A. Written Description Rejection

The Office rejects claim 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Office Action, p. 2. According to the Office, “[w]hen given the broadest reasonable interpretation, cultures ‘derived from’ said recited cultures encompass cultures having undergone mutation and/or alteration of culture phenotype.” *Id.* The Office asserts that the specification fails to support this genus of cell cultures. *Id.*

Applicant respectfully traverses. The written description requirement is satisfied where one of skill in the art would conclude that Applicant was in possession of the claimed invention. M.P.E.P. § 2163. Here, Applicant has described the recited cell lines, and has described cell cultures derived from cancer cell lines. See, e.g., Example 3. Applicant respectfully submits that Applicant was in possession of the claimed method because the specification describes the cell cultures of the claim. Nevertheless, solely to advance prosecution, and without acquiescing to the rejection, Applicant has amended claim 25 by deleting “derived from” and has added claim 31. Applicant respectfully requests that the Office withdraw the rejection.

B. Enablement Rejection

The Office rejects claim 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Office Action, p. 3. According to the Office, Applicant has not satisfied the deposit requirements for biological materials. According to the Office, “[t]here is no reasonable expectation that one of skill in the art could isolate cell lines identical to those claimed as the origin of the material depends upon mutational event[(s)] within a tumor in a cancer patient and therefore outside of the influence of one of skill in the art.” *Id.*

Applicant submits a copies of the deposit receipts from CNCM for the recited cell lines and a Deposit Declaration. Applicant respectfully requests that the Office withdraw the rejection.

IV. Claim 25 is Not Anticipated

A. **Bernard**

The Office rejects claim 25 under 35 U.S.C. § 102(b) as allegedly being anticipated by Bernard *et al.*, “Characterization of human ovarian adenocarcinoma line, IGROV1, in tissue culture and in nude mice,” Cancer Research, Vol. 45, pages 4970-4979, (1985) (“Bernard”). Office Action p. 4. According to the Office, Benard “disclose[s] a method of selecting a compound capable of inhibiting the growth and or proliferation of an IGROV1 tumor cell line,” and that, absent evidence to the contrary, “the claimed method appears to utilize the same cell line as the method of the prior art in terms of origin of primary cells.” *Id.* at 4-5.

Applicant respectfully traverses. To anticipate, all the elements of the claimed invention must be present in the alleged prior art reference, and that reference must enable the claimed invention. See M.P.E.P. § 2131; *see also Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. 2003).

Bernard does not anticipate claim 25 because it does not contain all the elements of that claim. First, the origin of the cell lines of the claimed method differs from that of Benard. IGR-OV-22-AS is derived from peritoneal ascites taken from a patient having a cancer of the ovarian epithelium. Specification, p. 17, lines 26-37. In contrast, the cell line of Benard was derived from an ovarian solid tumor. Benard, p. 4970, col. 2, under the heading “Origin of the Tumor.” Therefore, the origin of IGR-OV-22-AS differs from that of the Benard cell line. Similarly IGR-BR-11-NS was derived from a mammary tumor while the cell line of Bernard was derived from an ovarian solid tumor. Thus, the origin of IGR-BR-11-NS also differs from that of the Bernard cell line.

Second, the claimed method recites “selecting said compound if it is capable of inhibiting the growth and/or the proliferation of said tumor cells.” Bernard does not disclose this element of claim 25. Bernard exposed the IGROV1 cell line to several known anti-cancer drugs and measured their effects. Bernard, page 4972, col. 2. However, Bernard did not select those compounds based on their ability to inhibit the growth/and or proliferation of tumor cells because the compounds were already known anti-cancer drugs.

Third, Bernard does not enable the claimed method. The claimed method recites cell cultures comprising the tumor cell line IGR-OV-22-AS as deposited with the Collection Nationale de Cultures de Microorganismes (CNCM) under accession number I-2894 or comprising the tumor cell line of human origin IGR-BR-11-NS as deposited with the CNCM under accession number I-2895. As admitted by the Office, “[t]here is no reasonable expectation that one of skill in the art could isolate cell lines identical to those claimed as the origin of the material depends upon mutational event[(s)] within a tumor in a cancer patient and therefore outside of the influence of one of skill in the art.” Office Action p. 3. Applicant agrees that there is no reasonable expectation that the cell line of Bernard and those of the claimed methods are identical, and that one of skill in the art could not generate the claimed cell lines following the disclosure of Bernard because cancer cells arise from mutations that are beyond the control of the skilled artisan.

B. Nederman and Heldin

The Office rejects claims 1-3 under 35 U.S.C. § 102(b) as allegedly anticipated by Nederman *et al.*, “Demonstration of extracellular matrix in multicellular tumor spheroids,” Cancer Research, Vol. 44, pages 3090-97 (1984) (“Nederman”) as

evidenced by Heldin *et al.* "The molecular biology of the human anaplastic thyroid carcinoma cell," Thyroidology, Vol. 3, pages 127-31 Abstract (1991) (Heldin). Office Action, p. 5. Without acquiescing to the rejection, Applicant has cancelled claims 1-3 rendering the rejection moot.

V. Conclusion

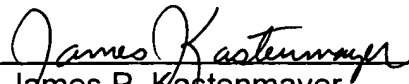
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: July 11, 2008

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